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Practitioner's Docket No. 944-003.112 (NC19367US)

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: S. Hamalainen, et al

Application No.: 09/977,578

Group No.: 2665

Filed: 15 October 2001

Examiner: Nguyen

For: **POWER CONTROL DURING COMPRESSED MODE**

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT TRANSMITTAL

1. Transmitted herewith is a Letter Accompanying a Revised Brief for Appellant (in triplicate) and the Supplemental Revised Brief (in triplicate) for this application.

STATUS

2. Applicant is

☐ a small entity. A statement:

☐ is attached.

☐ was already filed.

☒ other than a small entity.

CERTIFICATE OF MAILING/TRANSMISSION UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

☒ deposited with the United States Postal Service with sufficient postage as first-class mail, in an envelope addressed to Mail Stop Appeal Briefs - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

FACSIMILE

☐ transmitted by facsimile to the U.S. Patent and Trademark Office.

Date: 1 October 2007

Signature

Debbie A. Crucitti
(type or print name of person certifying)

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120.00 DP

EXTENSION OF TERM

NOTE: *Extension of Time in Patent Cases (Supplement Amendments) - If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

NOTE: See 37 C.F.R. §1.645 for extensions of time in interference proceedings, and 37 C.F.R. §1.550(c) for extensions of time in reexamination proceedings.

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. §1.136 apply.

(complete (a) or (b), as applicable)

- (a) ☒ Applicant petitions for an extension of time under 37 C.F.R. §1.136 (fees: 37 C.F.R. §1.17(a)(1)-(4)) for the total number of months checked below:

<u>Extension (months)</u>	<u>Fee for other than small entity</u>	<u>Fee for small entity</u>
<input checked="" type="checkbox"/> one month	\$ 120.00	\$ 60.00
<input type="checkbox"/> two months	\$ 450.00	\$225.00
<input type="checkbox"/> three months	\$1,020.00	\$510.00
<input type="checkbox"/> four months	\$1,590.00	\$795.00

Fee: \$ 120.00

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for _____ months has already been secured. The fee paid therefor of \$_____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

OR

- (b) ☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. §1.16(b)-(d)) has been calculated as shown below:

(Col. 1)	(Col. 2)	(Col. 3)	SMALL ENTITY			OTHER THAN A SMALL ENTITY	
CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDIT. FEE	OR	RATE	ADDIT. FEE
TOTAL:	MINUS	= 1	x \$ 25 = \$			x \$ 50 = \$	
INDEP:	MINUS	= 0	x \$100 = \$			x \$200= \$ 0	
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEP. CLAIM			+\$180=\$			+\$360=\$ 0	
			TOTAL ADDL. FEE	\$		TOTAL ADDL. FEE	\$ 0

WARNING: "After final rejection or action (§1.113) amendments may be made cancelling claims or complying with any requirement of form which has been made." 37 C.F.R. §1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

(c) ☒ No additional fee for claims is required.

OR

(d) ☐ Total additional fee for claims required is \$_____.

FEE PAYMENT

5. ☒ Attached is a check in the sum of \$ 120.00.

☐ Charge Account No. _____ the sum of \$_____. A duplicate of this transmittal is attached.

FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986 (1065 O.G. 31-33).

6. ☒ If any additional extension and/or fee is required, charge Account No. 23-0442

AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 23-0442

1 October 2007



Signature of Practitioner

Reg. No.: 32,720

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WFVA/NOKIA File Nos.: 944-3.112/NC19367US

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re application of: S. Hamalainen, et al

Serial No.: 09/977,578 : Group Art Unit: 2665

Filed: 15 October 2001 : Examiner: Nguyen

For: **POWER CONTROL DURING COMPRESSED MODE**

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REPLY BRIEF FOR APPELLANT

Sir:

This is a reply to an Answer mailed 29 June 2007.

RESPONSE TO SECTIONS (1) to (9) OF EXAMINER'S ANSWER

No reply.

RESPONSE TO SECTION (10) OF EXAMINER'S ANSWER

This is a reply to section (10) Response to Argument in the Examiner's Answer:

A. Paragraph Bridging Pages 16-17

In reply to the remarks in the paragraph bridging pages 16-17 of the Examiner's

Answer, it is respectfully submitted that applicants' Brief, page 9, lines 5-11, states as follows:

... [I]t is respectfully submitted that ... neither the admitted prior art, Vukovic nor the proposed combination thereof even remotely suggests the whole thrust of the claimed invention, which is to adjust the power level of the data

transmission in a compression mode of operation in the user equipment to a correct power level before a subsequent data transmission is sent, as claimed herein.

It is also respectfully submitted that when interpreting the subject matter of independent claims 1 or 11 consistent with that shown and described in the patent application, especially in view of that known in the prior art, a person skilled in the art would appreciate that according to the claimed invention the power level of data transmission in the compression mode of operation in the user equipment is adjusted to a correct power level before a subsequent data transmission is sent.

B. Paragraph on Page 17, lines 4-8

The paragraph on page 17, lines 4-8, of the Examiner's Answer provides a reply to the statement in applicants' Brief, page 9, lines 5-11.

First, the paragraph on page 17, lines 4-8, of the Examiner's Answer states that 'the limitation of "to adjust the power level of data transmission in a compression mode of operation" is not claimed.' Second, the paragraph on page 17, lines 4-8 states that: 'The claim merely states "implementing a compression mode of operation" without claiming that the data is transmitted in the compression mode and that the transmission data of the compression mode is ceased.'

In reply, it is respectfully submitted that these two sentences or statements in the paragraph on page 17, lines 4-8, are incorrect for the following reasons:

Consistent with that set forth above, applicants' February 12th Brief, page 9, lines 7-11, states that **"the whole thrust of the claimed invention ... is to adjust the power level**

of the data transmission in a compression mode of operation in the user equipment to a correct power level before a subsequent data transmission is sent, as claimed herein."

Regarding the first sentence or statement in the paragraph on page 17, lines 4-8, the preamble of the claim 1 recites that the present invention relates to "A method of implementing a compressed mode of operation in a mobile communication network in which data transmission and reception in user equipment is ceased so a required measurement can be made." ¹ [Underlined emphasis added.] The body of claim 1 recites that the present invention is characterized by the fact that "the power level of data transmission in the user equipment is adjusted to a correct power level before a subsequent data transmission is sent." ² [Underlined emphasis added.] Clearly, in contrast to the reasoning in the first sentence or statement in the paragraph on page 17, lines 4-8, of the Examiner's Answer, it is respectfully submitted that when the preamble of claim 1 and the body of claim 1 are read and interpreted in conjunction with one another, and further when read in conjunction with the patent application and prior art as a whole, a person skilled in the art would appreciate and interpret the language of claim 1 to mean that the power level of data transmission is adjusted in a compression mode of operation, as claimed. Because of this, it is respectfully submitted that the first sentence or statement in the paragraph on page 17, lines 4-8 is incorrect because this feature is recited in claim 1.

¹ Independent claim 11 recites user equipment having a similar limitation in the preamble of the claim.

² Again, independent claim 11 recites user equipment having a similar limitation in the body of the claim.

Regarding part one of the second sentence in the paragraph on page 17, lines 4-8, of the Examiner's Answer, it is respectfully submitted that neither the language of claim 1 nor the statement in applicants' February 12th Brief, page 9, lines 7-11, recites that "the data is transmitted in the compression mode." Instead, the power level adjustment is made in the compression mode. Clearly, claim 1 'states "implementing a compression mode of operation" without claiming that the data is transmitted in the compression mode,' consistent with that set forth in part one of this second sentence or statement in the paragraph on page 17, lines 4-8, of the Examiner's Answer.³ Because of this, it is respectfully submitted that part one of this second sentence or statement in the paragraph on page 17, lines 4-8, of the Examiner's Answer is correct on this point.⁴

However, regarding part two of the second sentence or statement in the paragraph on page 17, lines 4-8, of the Examiner's Answer, it is respectfully submitted that the preamble of claim 1 recites "implementing a compressed mode of operation in a mobile communication network in which data transmission and reception in user equipment is ceased" Clearly, according to the claimed invention, "the transmission data of the compression mode is ceased." Because of this, it is respectfully submitted that part two of the second sentence or statement in the paragraph on page 17, lines 4-8, of the Examiner's Answer, is incorrect, thus the second sentence or statement in the paragraph on page 17, lines 4-8, of the Examiner's Answer, *as a whole* is incorrect.

³ Independent claim 11 recites user equipment having a similar limitation.

⁴ It is respectfully submitted that the scope of the claimed invention is not intended to be limited to the same. For example, an alleged infringing device of claim 1 does not need to be transmitting the data in the compression mode in order to infringe claim 1.

C. Paragraph Bridging Pages 17-18 of the Examiner's Answer

The paragraph bridging pages 17-18 of the Examiner's Answer repeats almost verbatim the reasoning on page 6, lines 6-12, in the Examiner's Answer regarding why Vukovic allegedly teaches the body of claim 1, i.e. which states that the present invention is characterized in that "the power level of data transmission in the user equipment is adjusted to a correct power level before a subsequent data transmission is sent," as claimed.

Foremost, it is respectfully submitted that as set forth above both sentences or statements in the paragraph on page 17, lines 4-8, of the Examiner's Answer are incorrect and thus add nothing new to the repeated line of reasoning in the paragraph bridging pages 17-18 of the Examiner's Answer.

Second, consistent with, and as a supplement to, the arguments set forth in the February 12th Brief, page 9-10, applicants' reply to the repeated line of reasoning in the paragraph bridging pages 17-18 of the Examiner's Answer as follows:

Clearly, the admitted prior art does not teach or suggest an adjustment of the power level of the data transmission in a compression mode of operation, especially to correct the power level before a subsequent data transmission is sent. The reasoning in the paragraph on page 17, lines 4-8 of the Examiner's Answer, either overlooks or ignores this fundamental deficiency in the teaching of the admitted prior art.

Nevertheless, to try to make up for the deficiency in the teaching of the admitted prior art, the reasoning in the paragraph bridging pages 17-18 of the Examiner's Answer, looks to that disclosed in Vukovic. However, Vukovic's MS 302 merely adjusts the power level of

each access request until receiving an "ACK" or "NAK" back from the base station 306 in Figure 3, as set forth in paragraphs 21 to 23. **It is respectfully submitted that, similar to the admitted prior art, Vukovic's adjustment of the power level is not done during a compression mode of operation, especially to correct the power level before a subsequent data transmission is sent, as claimed.**

In view of this, both cited prior art references in the proposed combination are missing both critical pieces of the claimed invention - one, to adjust the power level during a compression mode of operation, and two, to correct the power level before a subsequent data transmission is sent when in this compression mode.

It is respectfully submitted that since Vukovic does not make up for the fundamental deficiency in the teaching of the admitted prior art in both of these most important regards, the proposed combination thereof does not, and cannot, result in the claimed invention.

Furthermore, It is respectfully submitted that the proposed combination is not proper under the patent laws because nothing on the record suggests why one of ordinary skill in the art would be motivated or desire to look to Vukovic to make up for these fundamental deficiencies in the teaching of the admitted prior art. For example, nothing on the record teaches or suggests to do so in order "to provide [a] readjusted power level after each halt during the compressed mode of operation for preventing a closed-loop distortion, thus reducing the frame error rate and block rate," as previously stated in the paragraph bridging pages 6-7 of the Examiner's Answer. Moreover, if one of ordinary skill in the art would be so motivated for some unexplained reason, then even when looking at Vukovic they would not find a solution to the problem being addressed by the claimed invention because Vukovic

does not teach, suggest or hint at the fact that the power level of data transmission in the compression mode of operation in the user equipment is adjusted to a correct power level before a subsequent data transmission is sent, as claimed. The instant patent application provides the only teaching or suggestion on the record to make such a data transmission power level adjustment and correction during the compression mode of operation, as claimed.

For all these reasons, it is respectfully submitted that the proposed combination of the cited prior art does not teach or suggest the claimed invention.

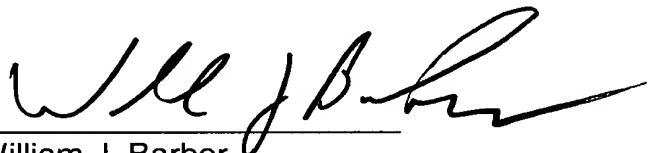
ALLOWABLE CLAIMS 3-5, 10, 13, 13-15 and 20-33

Although not stated in the Examiner's Answer, dependent claims 3-5, 10, 14-15 and 20-33 are indicated to allowable if rewritten or amended to include the base claim and any intervening claims. Moreover, claim 13 is an independent claim that recites a specific embodiment of the invention and is indicated to be allowable.

CONCLUSION

In view of this, it is respectfully submitted that the reasoning in the rejection of these claims is in error, and should be reversed.

Respectfully submitted,



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